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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,534	04/08/2004	Kevin Farley	2479.1007-004	8321

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EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2688

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/820,534	Applicant(s) FARLEY ET AL.	
	Examiner Jean A. Gelin	Art Unit 2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 30-37 is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 4, 6-9, 11-13, 16, 18-23, 25-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by La Porta (US 6,434,134 B1).

Regarding claim 1, La Porta teaches a method for providing wireless communication, the method comprising the steps of: (a) receiving, at a first cell site, data for a subscriber, the data including a wired-network address (i.e., wired subnetwork assigns a packet routing address to a mobile, col. 1, lines 52-56); (b) determining, based on the wired-network address, whether the subscriber is located in the cell site (whether it is in home or foreign domain col. 1, line 49 to col. 2, line 29); (c) if the subscriber is located in the cell site, retrieving a wireless-network identifier of the

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subscriber (i.e., dynamically adjusting the address, col. 2, lines 1-59, col. 5, line 1 to col. 6, line 22); and (d) transmitting the data, using the wireless-network identifier, via a wireless network to the subscriber (col. 5, lines 10-16).

Regarding claims 4, 8, 9, La Porta teaches a method for providing wireless communication, the method comprising the steps of: (a) receiving, in a first cell site, data for a subscriber, the data including a wired-network address (i.e., wired subnetwork assigns a packet routing address to a mobile, col. 1, lines 52-56; (b) determining, based on the wired-network address, whether the subscriber is located in a second cell site (whether it is in home or foreign domain col. 1, line 49 to col. 2, line 29); and (c) if the subscriber is located in the second cell site, sending the data, via a tunnel, to a second cell site for wireless transmission to the subscriber (col. 5, line 1 to col. 6, line 21).

Regarding claim 6, La Porta teaches receiving from the second cell, via a backhaul network, handoff information for the subscriber (col. 7, lines 1-21, col. 8, lines 4-45).

Regarding claim 7, La Porta teaches creating a tunnel over the backhaul network from the first cell site to the second cell site (col. 7, lines 1-21).

Regarding claims 11, 12, La Porta teaches wherein the subscriber's wired-network address is received from the first cell, and wherein the subscriber's wired-network address is received from the subscriber (see cols. 9-10).

Regarding claim 13, La Porta teaches an apparatus for providing wireless communication, the apparatus comprising: a processor (col. 17, lines 40-67, col. 9, lines 53-67, and col. 12, lines 1-23); and a memory coupled to said processor, said memory

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including a database that associates a subscriber's wired-network address with a subscriber's wireless network identifier, and said memory storing instructions adapted to be executed on said processor (col. 17, lines 40-67, col. 9, lines 53-67, and col. 12, lines 1-23), said instructions comprising: receiving, at a first cell site, data for a subscriber, the data including a wired-network address (i.e., wired subnetwork assigns a packet routing address to a mobile, col. 1, lines 52-56); determining, based on the wired-network address, whether the subscriber is located in the cell site (whether it is in home or foreign domain col. 1, line 49 to col. 2, line 29); if the subscriber is located in the cell site, retrieving a wireless-network identifier of the subscriber (i.e., dynamically adjusting the address, col. 2, lines 1-59, col. 5, line 1 to col. 6, line 22); and transmitting the data, using the wireless-network identifier, via a wireless network to the subscriber (col. 5, lines 10-16).

Regarding claims 16, 20, 21, La Porta teaches an apparatus for providing wireless communication, the apparatus comprising: a processor (col. 17, lines 40-67, col. 9, lines 53-67, and col. 12, lines 1-23); and a memory coupled to said processor, said memory including a database that associates a subscriber's wired-network address with a subscriber's wireless network identifier, and said memory storing instructions adapted to be executed on said processor (col. 17, lines 40-67, col. 9, lines 53-67, and col. 12, lines 1-23), said instructions comprising receiving, in a first cell site, data for a subscriber, the data including a wired-network address (i.e., wired subnetwork assigns a packet routing address to a mobile, col. 1, lines 52-56); determining, based on the wired-network address, whether the subscriber is located in a second cell site (whether it is in

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home or foreign domain col. 1, line 49 to col. 2, line 29); and if the subscriber is located in the second cell site, sending the data, via a tunnel, to a second cell site for wireless transmission to the subscriber (col. 5, line 1 to col. 6, line 21).

Regarding claim 18, La Porta teaches said memory storing further instructions adapted to be executed by said processor, said further instructions comprising: (iv) receiving from the second cell, via a backhaul network, handoff information for the subscriber (col. 8, lines 4-26, col. 12, lines 25-47).

Regarding claim 19, La Porta teaches said memory storing further instructions adapted to be executed by said processor, said further instructions comprising: (v) creating a tunnel over the backhaul network from the first cell site to the second cell site (col. 8, lines 4-67 and 12, lines 5-26).

Regarding claims 22, 23 La Porta teaches wherein the subscriber's wired-network address is received from the first cell, and wherein the subscriber's wired-network address is received from the subscriber (see cols. 9-10).

Regarding claims 25, La Porta teaches receiving a request for a wired-network address (col. 32, lines 21-57); identifying an originating cell site (col. 32, line 21 to col. 33, line 11); identifying an unoccupied address associated with the originating cell site (col. 33, line 39 to col. 34, line 55); and (d) assigning the unoccupied address to the subscriber (col. 34, lines 1-67).

Regarding claim 28, La Porta teaches a processor (col. 17, lines 40-67, col. 9, lines 53-67, and col. 12, lines 1-23); a memory coupled to said processor, said memory storing instructions adapted to be executed on said processor (col. 17, lines 40-67, col.

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9, lines 53-67, and col. 12, lines 1-23), said instructions comprising: receiving a request for a wired-network address (col. 32, lines 21-57); identifying an originating cell site (col. 32, line 21 to col. 33, line 11); identifying an unoccupied address associated with the originating cell site (col. 33, line 39 to col. 34, line 55); and (d) assigning the unoccupied address to the subscriber (col. 34, lines 1-67).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Porta in view of Wong (US 5,905,773).

Regarding claims 3, 15, La Porta teaches all the limitations above except wherein the wireless-network identifier is an electronic serial number (ESN).

However, the preceding limitation is known in the art of communications. Wong teaches that the switching network assigns individual ESN numbers to each location within the private network (corresponding the use of ESN as ID of the network, col. 2, lines 15-25, col. 3, lines 53-57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Wong within the system of La Porta in order to use location identifier to reduce the perplexity of a speech recognition application.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, 4, 6-9, 11-13, 15, 16, 18-23, 25, and 28 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,725,047 in view of La Porta (US 6,434,134).

Regarding claim 1, the U.S. Patent No. 6,725,047 teaches a method for providing wireless communication, the method comprising the steps of: (a) receiving data for a subscriber, the data including a wired-network address; (b) determining whether the data was received via a tunnel; (c) if the data was received via the tunnel, retrieving the wireless-network address of the subscriber; and (d) transmitting the data to the subscriber and the determining step is based on the wired-network address (see claims 1 and 6).



U.S. Patent No. 6,725,047 does not specifically teach determining whether the subscriber is located in the cell site.

However, the preceding limitation is known in the art of communications. La Porta teaches determining whether the base station is attached to a home or foreign domain to dynamically adjust the address of the mobile device (i.e., location of the device). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of La Porta within the system of U.S. Patent No. 6,725,047 in order that the number of active packets routing address assignment is reduced and triangular packet routing is minimized by assigning a packet routing address to a mobile device accessing a wired subnet upon power up of the mobile.

7. Claims 3, 4, 6-9, 11-13, 15, 16, 18-23, 25, and 28 include limitations that are similar to claims 1-13. Therefore, there are for the same reasons recited above.

Claims 1-13 of patent # 6,725,134 contain every element of claims 1, 3, 4, 6-9, 11-13, 15, 16, 18-23, 25, and 28 of the instant application and as such anticipate claims 1, 3, 4, 6-9, 11-13, 15, 16, 18-23, 25, and 28 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-

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type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

### ***Allowable Subject Matter***

8. Claims 30-37 are allowed.
9. Claims 2, 5, 10, 14, 17, 24, 27, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcome the Double Patent rejection.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yegoshin	US 6,711,146	03/23/2004
Shaughnessy et al	US 6,141,347	10/31/2000
Reissner	US 5,594,731	01/14/1997

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

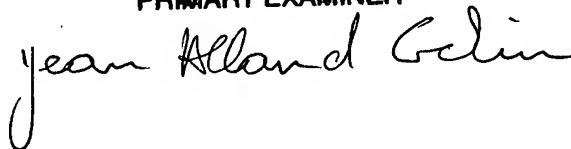
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JEAN GELIN**  
**PRIMARY EXAMINER**

JGelin  
December 6, 2005

A handwritten signature in cursive script that reads "jean Allard Gelin". The signature is written in black ink and is positioned to the right of the typed name and title.